

REMARKS – General

The Objection To The Specification And The Claims Rejection Under § 112

Applicants have deleted “(no more than 150 words)” from abstract section. The claim 5 has been replaced by claims 12 to 14 because Office Action required that each of the claims should only consist of one sentence. Claim 7 has been canceled. A “.” has been inserted after “pages turning” on the original claim 7 (current claim 16).

Claims 1-7 was rejected under 35 U.S.C. 112, first paragraph, because the specification. To meet the requirement, the claim 1 (e) “two identical hook-and-loop fastening pad straps” has been changed to “two identical fastening straps”. The original claim 1 is current claim 9. The two identical mating pad of hook and loop fasteners mean 2 pads of hook and 2 pads of loop.

Claims 2, 4, 5, 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out an distinctly claim the subject matter applicant regards as the invention.

Applicants request reconsideration and withdrawal of this rejection since the present specification clearly shows that the claims particularly pointing out the subject matter which the applicant regards as their invention. For example, the applicants said that this invention provides a supporting platform on the vehicle’s steering wheel for reading writing or watching (p.1). This book holding device fit to most steering wheel and need only take several seconds to install to or uninstall from the steering wheel. It is lightweight, especially compact for store. It can hold pen or pencil and prevent the book pages from turning (p. 2). Its manufacture cost is relatively low (p. 3).

In addition, all insufficient antecedent basis for the limitation in the claim 2, 4, 5 and 6 have been corrected.

Accordingly applicants submit that the specification does comply with § 112 and therefore request withdrawal of this rejection.

The Rejection Of Claim 1-7 On Malinski, Shioda, Brennan, Joye and Gerald Is Overcome

As Office Action said that claims 1-7 are rejected, as best understood, under 35 U.S.C.103 (a) as being unpatentable over Malinski 5,060,581 in view of Shioda 5,385,283 in view of Brennan 2,374,409 in view of Joye 5,642,674 and in further view of Gerald 3,747,889.

Claims 1-7 have been rewritten as new claim 8-16 to define patentably over these references, and any combination thereof. Applicants request reconsideration and withdrawal of this rejection for the following reasons:

- (1) The present invention is unobviousness because the large number (The number is 5 here) of references must be combined to meet the invention.
- (2) To get the suggested combination, a series of separate, awkward combinative steps have been taken. So, this is evidence of unobviousness.
- (3) In these five references, two (Brennan 2,374,409 and Gerald 3,747,889) are conventional book holding devices, one (Joye 5,642,674) comes from eating holding device. Only two (Malinski 5,060,581 and Shioda 5,385,283) come from book holding device on the steering wheel field. So, at least there is one reference is from a very different technical field. It's "nonanalogous art".
- (4) After reading these five references, applicants know that the prior-art references do not contain any suggestion that they be combined or that they be combined in the manner suggested.
- (5) Each reference is complete and functional in itself, so there would be no reason to use parts from or add or substitute parts to any reference. They are individually complete.
- (6) The whole result achieved by the invention is greater than the sum of its parts since Malinski's 5,060,581 device shelf (15) is not foldable and an attachment means (11) is difficult to fit different size steering wheels. Shioda 5,385,283 uses that mating hook and loop fastener means for further securing the U-shaped ends of the securing portions to the inner rim of the steering wheel instead of use as the purpose to hang the book holding device on the steering wheel. Brennan 2,374,409 has a foldable shelf that is prevent the objects that put on the supporting platform will not out of the way instead of functioned as supporting platform. The device (Brennan 2,374,409) has elastic loops (76) for holding eating utensils (16) instead of for holding pen or pencil. Gerald's (3,747,889) elastic bands (21) can not provide a means of preventing pages of books from turning, if the book is thin or reader read the book first few pages or last few pages.
- (7) The present invention started to enter the market and get sale increase on the internet shop and on the local 'Seen as on TV' shops. The product pictures could be found at the website www.agreata.com and the feedback from eBay is another evidence that this application is unobvious.
- (8) Malinski 5,060,581, Shioda 5,385,283, Brennan 2,374,409, Joye 5,642,674 and Gerald 3,747,889 do not contain any justification to support their combination, much less in the manner proposed with regard to the proposed combination of Malinski 5,060,581, Shioda 5,385,283, Brennan 2,374,409, Joye 5,642,674 and Gerald 3,747,889. It is well known that in order for any prior-art references themselves to be validly combined for use in a prior-art § 103 rejection. The references themselves (or some other prior art) must suggest that they be

combined. E.g., as was stated in In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983):

“[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.”

That the suggestion to combine the reference should not come from applicant was forcefully stated in Orthopedic Equipment Co. v. United States, 217 U.S.P.Q. 193, 199 (CAFC 1983):

“It is wrong to use the patent in suit [here the patent application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law [here the PTO].”

As was further stated in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988). “[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there from the invention itself... something in the prior art must suggest the desirability and thus the obviousness of making the combination.”

In line with these decisions, recently the Board stated in Ex parte Levengood, 28 U.S. P.Q. 2d 1300 (P.T.O.B.A.&I. 1993):

“In order to establish a *prima facie* case of obviousness, it is necessary for examiner to present evidence, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teaching of the, applied references in the proposed manner to arrive at the claimed invention, ... That which is within the capabilities of one skilled in the art is not synonymous with obviousness. ... That one can reconstruct and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.... Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that ‘would lead’ that individual ‘to combine the relevant teachings of references.’ ... Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant’s invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done.”

In the present case, there is no reason given in the last O.A. to support the proposed combination.

Since the claims define novel structure that produces new and unexpected results (1) save install and uninstall time (2) save the storage space. So, applicants submit that such claims are clearly patentable.

Conclusion

For all of the above reasons, applicants submit that the specification and claims are now in proper form, and that the claims all define patentably over the prior art. Therefore they submit that this application is now in condition for allowance, which action they respectfully solicit.

Conditional Request For Constructive Assistance

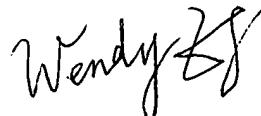
Applicants have amended the specification and claims of this application so that they are proper, definite, and define novel structure which is also unobvious. If for any reason this application is not believed to be in full condition for allowance, applicants respectfully request the constructive assistance and suggestions of the Examiner pursuant to M.P.E.P. & 2173.02 and & 707.07(j) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

Very respectfully,

James Guo



Wendy Zang



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